UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,817	02/25/2002	Susan G. Stuart	PA-0046 US	2278

27904 7590 11/20/2003

INCYTE CORPORATION (formerly known as Incyte Genomics, Inc.)
3160 PORTER DRIVE
PALO ALTO, CA 94304

EXAMINER	
MARTINELL, JAMES	
ART UNIT	**PAPER NUMBER**
1631	

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/084,817	STUART ET AL.	
	Examin r	Art Unit	
	James Martinell	1631	

-- The MAILING DATE of this communication app ars on the cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _/__ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) _____ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8, drawn to combinations of cDNAs and nucleic acid molecular hybridization methods, classified in class 536, subclass 23.5 and class 435, subclass 6.

II. Claims 9-14, drawn to cDNAs, vectors, host cells, methods for producing proteins, and nucleic acid molecular hybridization assays, classified in class 536, subclass 23.5 and class 435, subclasses 320.1, 325, 252.3, and 6.

III. Claim 15 drawn to polypeptides, classified in class 530, subclass 350.

IV. Claims 16 and 17, drawn to screening methods for identification of compounds that bind proteins, classified in class 435, subclass 7.1.

V. Claims 18-20, drawn to antibodies, methods of making antibodies, and antibody assays, classified in class 530, subclass 387.1 and class 435, subclass 7.1.

The inventions are distinct, each from the other for the following reasons. The nucleic acid combinations and nucleic acid molecular hybridization assays using nucleic acid combinations of Group I are materially different from, and are therefore independent and distinct from, the isolated nucleic acids and nucleic acid molecular hybridization assays using isolated nucleic acids of Group II. The nucleic acid hybridization methods of Group I may be practiced independently of the protein production methods of Group II. The nucleic acid combinations of Group I are materially different from, and are therefore independent and distinct from, the proteins of Group III and the antibodies of Group V. The methods of Group I may be practiced independently of the methods of Groups IV and V. The cDNAs, vectors, and host cells of Group II are materially different from, and are therefore independent and distinct from, the proteins of Group III and the antibodies of Group V. The cDNAs, vectors, and host cells of Group II are not needed to practice the methods of Groups IV or V. The methods of Group II may be practiced independently of the methods of Groups IV and V. The proteins of Group III have uses other than in the method of Group IV (*e.g.*, for the production of antibodies). The proteins of Group III have uses other than in the methods of Group IV (*e.g.*, in affinity chromatography). The proteins of Group III are

materially different from, and are therefore independent and distinct from, the antibodies of Group V. The methods of Groups IV and V may be practiced independently of one another.

Claims 1-8 are drawn to compositions reciting different combinations of individual nucleotide sequences. Applicant is required to select one combination for examination. If the selected combination contains ten or fewer sequences, all of the sequences of the combination will be searched. If the selected combination contains more than ten sequences, the combination will be searched until one nucleotide sequence is found to be allowable. The order of searching will be chosen by the examiner to maximize the identification of an allowable sequence. If no individual nucleotide sequence is found to be allowable, the examiner will consider whether the combination of sequences taken as a whole renders the claims allowable. The identification of any allowable sequence(s) will cause all combinations containing the allowed sequence(s) to be allowed. See O.G. 68 (November 19, 1996).

Claims 9-14 are drawn to nucleotides, nucleotide constructs, and/or methods requiring the use of nucleotides or nucleotide constructs that contain more than one individual, independent, and distinct nucleotide sequence in alternative form. Accordingly, these claims are subject to restriction under 35 U.S.C. § 121 as outlined in 1192 O.G. 68 (November 19, 1996). This notice permits the examination of from one to ten independent and distinct nucleotide sequences in a single application based upon USPTO resources.

Should applicant elect a Group that claims or mentions more than one polynucleotide sequence, applicant is further required to select no more than ONE of the individual sequences for examination. The search of the no more than ONE selected sequence may include the complement of the selected sequence and, where appropriate, may include subsequences within the selected sequence (*e.g.,* oligomeric probes and/or primers).

Claims 15-20 are drawn to large numbers of polypeptides or mention or require the use of large numbers of polypeptides. Should applicant elect a Group that claims or mentions more than one polypeptide sequence, applicant is further required to elect one polypeptide sequence within the elected Group for examination on the merits.

To search any two groups as outlined above would create an undue burden for the U.S. PTO because the searches of the non-patent literature are not only non-overlapping to any appreciable extent, but are also divergent in nature.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their different classification and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Reminder Regarding *In re Ochiai* and *In re Brouwer*

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner bee the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The fax phone number for Examiner Martinell's desktop workstation is (703) 746-5162. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 305-4028.

PLEASE NOTE THE NEW FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

James Martinell, Ph.D.
Primary Examiner
Art Unit 1631